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Remarks

Reconsideration of the above-captioned application is respectfully requested. Independent Claims 1 and 10 and dependent Claim 6 have been rejected under 35 U.S.C. §102 as being anticipated by Harding, USPN 3,861,434 and as being anticipated by Chang, USPN 4,829,943. Moreover, independent Claim 1 and its dependent Claims 3-5 have been rejected under 35 U.S.C. §102 as being anticipated by White, USPN 4,858,361, and both independent Claims 1 and 10 and dependent Claims 2, 7, 12, and 16 have been rejected under 35 U.S.C. §102 as being anticipated by Japan '335.

In addition to the anticipation rejections, Claims 1 and 3-5 have been rejected under 35 U.S.C. §103 as being unpatentable over Rosenow, USPN 3,145,749 in view of Russell, USPN 3,161,932 or Kurt, USPN 3,008,209. Claims 6, 7, 10, 12, and 13 have been rejected under 35 U.S.C. §103 as being unpatentable over Rosenow in view of Russell or Kurt and further in view of Lauretti, USPN 2,422,245, Claim 8 has been rejected under 35 U.S.C. §103 as being unpatentable over Rosenow and Russell/Kurt and further in view of Halter, USPN 2,705,039 or Workman, USPN 4,784,248, and Claims 1, 3-7, 10, 12, and 13 have been rejected under 35 U.S.C. §103 as being unpatentable over Lauretti in view of Russell or Kurt. Claims 14 and 15 have been rejected under 35 U.S.C. §103 as being unpatentable over Lauretti in view of Russell or Kurt and further in view of Bergloff et al.

Applicant respectfully reminds the examiner that under MPEP §706(III), unclaimed patentable subject matter should be brought to an applicant's attention.

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The fact that Applicant has focussed its comments distinguishing the present claims from the applied references and countering certain rejections must not be construed as acquiescence in other portions of rejections not specifically addressed.

To overcome the rejections, the claims have been amended to positively recite a golf club as originally disclosed in, e.g., paragraph 19 of the present specification and as now shown in the substitute figures. No new matter has been entered.

More particularly, Claim 1 as now amended recites a golf club having a head in combination with a cover body. Claim 1 requires the cover body to define a lower portion for surrounding a portion of a shaft of the golf club and formed with at least first and second longitudinal edges generally parallel to the shaft with the edges meeting each other in a closed configuration and being distanced from each other in an open configuration. Claim 1 further requires a first elongated magnetic fastener positioned along the first edge and a second elongated magnetic fastener positioned along the second edge and being attracted to the first magnetic fastener to hold the edges together in the closed configuration. Support for this amendment can be found, among other places, in paragraph 19 and in figure 1. Various dependent claims have been amended or canceled to account for the amendment to Claim 1.

Similarly, independent Claim 10 now also recites a golf club head that is held in the compartment of a cover body and defining an elongated closable opening of sufficient size for the head to be inserted into and removed from the inner compartment. As now specified in Claim 10, the opening defines at least one pair of first and second elongated edges that are generally parallel to each other. Claim 10 further requires a magnetic fastener having first and second elongated magnetic portions spaced apart from one another and

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arranged along respective edges, so that the magnetic portions attract each other to hold the edges together
to shut the opening.

New independent Claim 17 has also been added to define inventive aspects in method terms.

Rejections Under 35 U.S.C. §102

Independent Claims 1 and 10 and dependent Claim 6 have been rejected under 35 U.S.C. §102 as being anticipated by Harding, USPN 3,861,434 and as being anticipated by Chang, USPN 4,829,943. Moreover, independent Claim 1 and its dependent Claims 3-5 have been rejected under 35 U.S.C. §102 as being anticipated by White, USPN 4,858,361, and both independent Claims 1 and 10 and dependent Claims 2, 7, 12, and 16 have been rejected under 35 U.S.C. §102 as being anticipated by Japan '335.

Prior to discussing the rejections and the amendments made herein to overcome them, Applicant would like to respectfully remind the examiner that rejections should be strictly confined to the best available art, and that cumulative rejections should be avoided, MPEP §706.02.

To dispose of Japan '335 first, the reference bears a publication date after the present application, and hence is not prior art. Understanding this, the examiner has used the Japan reference as 102(f) prior art, but in accordance with MPEP §2137, a rejection under 35 U.S.C. §102(f) generally requires evidence of derivation. No such evidence has been made of record, removing Japan '335 as prior art.

Considering Chang next, this reference is directed to an eyeglasses case or contact lens case cover. It nowhere mentions golf clubs, much less how it might be stretched to cover one. The anticipation rejection based on Chang is overcome.

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White is directed to a rifle cover that nowhere mentions golf clubs or how, precisely, it might be modified to cover a golf club. Instead, White covers a rifle. Rifles are typically not allowed in golf, not even to "shoot a birdie" and never, heaven forbid, to "score an eagle". The anticipation rejection based on White is overcome.

This leaves Harding as the sole remaining Section 102 reference. In Harding, the magnets 29 do not hold the edges of anything together, much less the edges of a slit or opening in a head cover as now claimed. Instead, the magnets 29 of Harding are intended for a different operation than the one now claimed. Specifically, the magnets 29 are attracted to ferrous material in either the head or shaft of the golf club, Harding col. 2, lines 27-34. Nowhere does Harding suggest that the head cover be formed with any elongated opening or slit much less that the magnets be arranged along edges of the opening or slit to hold the unshown edges together, and indeed one would not expect Harding to suggest this because Harding contemplates a magnetic coupling between the head cover and the golf club itself.

In fact, the only opening shown in Harding is the non-elongated bottom circular opening near reference numeral 15 in figure 1 of Harding, the single periphery of which is transverse to the golf club shaft. In contrast, Claim 1 requires longitudinal edges generally parallel to the shaft, and Claim 10 requires elongated edges parallel to each other. Thus, Harding neither teaches nor suggests a head cover with a longitudinal opening, and furthermore it does not even teach or suggest that its very different bottom circular opening is held shut by its magnets 29, which instead are disposed in positions that would make it impossible for them to close the opening as opposed to execute their intended function of attracting themselves to the golf club proper. The rejection is overcome.

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Rejections Under 35 U.S.C. §103

Claims 1 and 3-5 have been rejected under 35 U.S.C. §103 as being unpatentable over Rosenow, USPN 3,145,749 in view of Russell, USPN 3,161,932 or Kurt, USPN 3,008,209. Claims 6, 7, 10, 12, and 13 have been rejected under 35 U.S.C. §103 as being unpatentable over Rosenow in view of Russell or Kurt and further in view of Lauretti, USPN 2,422,245, Claim 8 has been rejected under 35 U.S.C. §103 as being unpatentable over Rosenow and Russell/Kurt and further in view of Halter, USPN 2,705,039 or Workman, USPN 4,784,248, and Claims 1, 3-7, 10, 12, and 13 have been rejected under 35 U.S.C. §103 as being unpatentable over Lauretti in view of Russell or Kurt. Claims 14 and 15 have been rejected under 35 U.S.C. §103 as being unpatentable over Lauretti in view of Russell or Kurt and further in view of Bergloff et al.

To rely on a reference under 35 U.S.C. §103, it must be analogous prior art, MPEP §2141.01(a). To be analogous, a reference must be one which, because of the subject matter with which it deals, logically would have commended itself to an inventor's attention in solving his problem, in this case, in how to conveniently cover the head and part of the shaft of a golf club, *id.* Of central importance in making the analogousness determination is similarity and differences in structure and function, *id.* In making this consideration, an initial step in defining what is and is not analogous art is to define the person of ordinary skill in the art of the subject invention, since if a person of ordinary skill in the relevant art is for example a dyer, not a chemist, the person may have no knowledge of chemistry and hence chemical references would not be analogous, Dystar Textilfarben GmbH v. C. H. Patrick Co., 464

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F.3d 1356 (Fed. Cir. 2006). The burden in establishing analogousness lies with the proponent of a reference, in this case, with the examiner.

Accordingly, with the above legal background in mind, in the present case it must be first determined, based on evidence, who the person of ordinary skill in the art is, and then, for each reference below, evidence must be produced to show why its field so seemingly alien to golf clubs nonetheless logically would have commended itself to the skilled artisan:

1. Russell (fasteners for baby dresses, thus having markedly different function if not structure than the present claims and hence being *prima facie* non-analogous absent refutative evidence of record, which has not been produced).
2. Kurt (fasteners for clothing, presumably not just baby dresses but in any case having markedly different function if not structure than the present claims and hence being *prima facie* non-analogous absent refutative evidence of record, which has not been produced).
3. Workman (extruded piping for luggage, thus having markedly different function if not structure than the present claims and hence being *prima facie* non-analogous absent refutative evidence of record, which has not been produced).
4. Berglof et al. (clamps for campaign buttons and name tags, thus having markedly different function if not structure than the present claims and hence being *prima facie* non-analogous absent refutative evidence of record, which has not been produced).

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The rejection of Claims 1 and 3-5 based on Rosenow and Russell or Kurt falls because (1) neither secondary reference is analogous to the present claims; (2) there is no suggestion in either secondary reference that it may be used with golf clubs, much less that it is equivalent to the golf club head cover zipper of Rosenow; and (3) Rosenow nowhere suggests an equivalence between head cover zippers and magnets.

The rejection of Claims 6, 7, 10, 12, and 13 based on Rosenow in view of Russell or Kurt and further in view of Lauretti falls because (1) neither Russell nor Kurt is analogous to the present claims; (2) there is no suggestion in either Russell or Kurt that it may be used with golf clubs, much less that it is equivalent to the golf club head cover zipper of Rosenow; and (3) Rosenow nowhere suggests an equivalence between head cover zippers and magnets.

The rejection of Claims 1, 3-7, 10, 12, and 13 based on Lauretti in view of Russell or Kurt falls for reasons above, as do the rejections of various dependent claims including Claims 8, 14 and 15.

Since the independent claims are now allowable, rejoinder of the non-elected dependent claims is hereby requested under MPEP §821.04.


The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

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